

## **REMARKS**

The Examiner is thanked for telephonically contacting the Applicant in order to clarify issues regarding the pending application. Reconsideration and withdrawal of the rejections of the pending claims are respectfully requested in view of the amendments and remarks herein, which were discussed during the interview with the Examiner, and which place the application in condition for allowance.

### **I. STATUS OF CLAIMS AND FORMAL MATTERS**

Claims 1 is amended, support for which is found in the specification under Table B. 50-54 and Table D. 32 and 33.

Claims 2-4 and 7-9 are currently pending.

No new matter has been introduced.

It is submitted that the claims herewith are patentably distinct over the prior art, and these claims are in full compliance with the requirements of 35 U.S.C. §112. The amendments to the claims presented herein are not made for purposes of patentability within the meaning of 35 U.S.C. §§§§ 101, 102, 103 or 112. Rather, these amendments and additions are made simply to clarify the scope of protection to which Applicants are entitled.

The issues raised by the Examiner in the Office Action are addressed below.

### **II. THE REJECTIONS UNDER 35 U.S.C. § 103 ARE OVERCOME**

Claims 1-4 and 7-9 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Cassayre (U.S. Patent No. 6,933,260) in view of Meinke et al. (U.S. Patent No. 5,208,222). Applicants respectfully traverse.

Establishing a *prima facie* case of obviousness requires that the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP 2143.

The Examiner is respectfully reminded of the case law, namely, that there must be some prior art teaching which would have provided the necessary incentive or motivation for modifying the reference teachings. *In re Laskowski*, 12 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Obukowitz*, 27 U.S.P.Q. 2d 1063 (BOPAI 1993). As stated by the Court in *In re Fritch*, 23 U.S.P.Q. 2d 1780, 1783-1784 (Fed. Cir. 1992): “The mere fact that the prior art may be modified in the manner suggested by the Office Action does not make the modification obvious unless the

prior art suggests the desirability of the modification.” Also, the Examiner is respectfully reminded that for the Section 103 rejection to be proper, both the suggestion of the claimed invention and the expectation of success must be founded in the prior art, and not Applicants' disclosure. *In re Dow*, 5 U.S.P.Q.2d 1529, 1531 (Fed. Cir. 1988). Furthermore, the Supreme Court has recently reaffirmed the factors set out in *Graham v. John Deere Co. of Kansas City*, 383 U.S. 1, 17-18: “[T]he scope and content of the prior art are determined; differences between the prior art and the claims at issue are...ascertained; and the level of ordinary skill in the pertinent art resolved. Against this background the obviousness or nonobviousness of the subject matter is determined. Such secondary considerations as commercial success, long felt but unsolved needs, failure of others, etc., might be utilized to give light to the circumstances surrounding the origin of the subject matter sought to be patented.” *KSR International Co. v. Teleflex Inc.*, 550 U.S. \_\_\_\_ (2007).

Applying the law to the instant facts, the references relied upon by the Office Action do not disclose, suggest or enable Applicants' invention.

Although the Applicants do not agree with the Office Action, in the interest of expediting prosecution, claim 1 has been amended to remove R<sub>2</sub> and R<sub>3</sub> substituents which allegedly overlap with Cassayre (US 6,933,260) and Meinke (US 5,208,222). Cassayre and Meinke, alone or in combination, do not teach or suggest the presently claimed invention. Accordingly, reconsideration and withdrawal of the rejections under 35 U.S.C. § 103 are respectfully requested.